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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,078	07/02/2001	Chikako Tsuchiyama	ASA-1012	9093

24956 7590 07/07/2006

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.  
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ALEXANDRIA, VA 22314

EXAMINER

SHIFERAW, ELENI A

ART UNIT PAPER NUMBER

2136

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/895,078	TSUCHIYAMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eleni A. Shiferaw	2136	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/24/2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's arguments and amendments with respect amended claims 1, 29 and 32 and added claims 33-34, and presently pending claims 26-34, filed on 04/24/2006 have been fully considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. US 6,226,618 B1) in view of De Boor WO 99/59283.

Regarding claims 26, 29, and 32, Downs et al. teaches a method/apparatus/medium comprising:

a receiving unit (*end-user device*) for receiving an image (*watermarked content/image*) symbolically expressing a content of data embedded in the image by means of electronic watermark techniques (col. 7 lines 40-65; *end-user receiving unit receiving data embedded content: data i.e. usage, license conditions, date, and any pertinent information...*), the data including information that is desired to be disclosed by an information exhibitor (col. 6 lines 37-48; *user desired contents like pictures, movies, videos, music programs, multimedia, games...*),

Art Unit: 2136

information as to an expiration term to be used to control display of said information that is desired to be disclosed (col. 24 lines 65-col. 25 lines 36; *expiration date of the content*), and information as to electronic signature to be used to conduct verification of authenticity of both said information that is desired to be disclosed and said information as to the expiration term (col. 24 lines 65-col. 25 lines 36; *signing content, expiration date and ...using private key*);

a storage unit storing a public key for decoding said information as to electronic signature (col. 34 lines 33-42, and col. 12 lines 37-44; *stored public key to verify digital signature and the well-known content control using digital signature, watermarking, certificate...*);

a display unit for displaying information (col. 33 lines 64-68; *end-user device displaying content URLs/HTMLs/web pages*); and

a control unit for extracting the data embedded in the image (col. 82 lines 8-9; *extracting embedded watermarking data*),

decoding the information as to electronic signature of the data extracted by using the public key stored in said storage unit (col. 32 lines 43-48, col. 44 lines 9-12, and col. 13 lines 67-col. 14 lines 27; *decoding extracted signature public key stored*),

verifying authenticity of both said information that is desired to be disclosed and said information as to the expiration term by using the information as to electronic signature thus decoded (col. 34 lines 39-41, col. 40 lines 65-68, col. 14 lines 38-45, and col. 44 lines 6-41; *verifying content and expiration date of the content*),

comparing the information as to the expiration term with information as to a clock of said data terminal (col. 14 lines 19-27, col. 34 lines 55-col. 35, and col. 40 lines 65-68; *authenticating and verifying using expiration date of the content*),

displaying said image mark (*watermarked/embedded content*) on the display of said data terminal if a current time obtained from said information as to the clock falls within said expiration term represented by said information as to the expiration term (col. 21 lines 43-58 and col. 59 lines 55-59; *usage condition/expiration date/term of content is verified first before rendering the desired watermarked content*), and

displaying said information that is desired to be disclosed on the display of said data terminal by selecting said image mark (*watermarked content*) displayed on the display (col. 73 lines 13-19 and col. 26 lines 35-67; *selecting the desired link of the displayed watermarked content, URL metadata (data related to content) is included in the watermarked content and URL metadata further includes HTML pages for further content information*).

Downs et al. fails to disclose an image mark, and displaying, on the display of said terminal, a menu as to said information that is desired to be disclosed, and if the menu is selected, then displaying said information that is desired to be disclosed embedded in the image mark. However De Boor discloses an advertisement banner/image mark that embeds data inside the advertisement banner/image mark and when the user looks at the advertisement banner/image mark and if user is interested on going to the data that is embedded inside the banner, the user selects the advertisement banner so the user can access the information by going to the embedded data or linked inside the advertisement banner (Abstract, and pages 3 lines 27-page 4 lines 31).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of De Boor within the system of Downs et al. because they are analogous in data distribution and authentication. One would have been

motivated to incorporate the teachings of De Boor within in Downs et al.'s system because it provides an easy way of informing/advertising the user by displaying an advertisement banner/image mark to provide signed/authenticated content to the user (pages 26 lines 31-27 lines 11).

Regarding claims 27, 30, and 33 Downs et al. further teaches the data display method/apparatus wherein, if it is judged that the authenticity is lower than a predetermined level in said step of verifying authenticity, said image mark is not displayed on this display (col. 16 decryption process of fig. 4 element 416, col. 21 lines 54-58, col. 33 lines 43-col. 34 lines 50, and col. 19 lines 66-col. 20 lines 49).

Regarding claims 28, 31, and 34 Downs et al. further teaches the data display method/apparatus wherein said information that is desired to be disclosed includes information as to a location at which detailed information of said data embedded in said image mark exists (col. 75 lines 50-col. 77 lines 23, col. 21 lines 54-57, and col. 79 lines 11-41).

### *Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US 6,122,403 Rhoads:** *discloses image marking technique or embedding URL into image, and digital signature.*

**WO 99/59283 DE BOOR:** *discloses banner advertisement method and secure content display system. Contents are not displayed unless the verification of the content clock information matches with the terminal clock using digital watermarking method.*

**US 6,108,703 Leighton et al.:** *discloses embedding HTML pages in content.*

**Pub. No.: US 2005/0283610 A1 Serret-Avila et al.:** *teaches protecting data using digital signature and watermarking techniques.*

See from PTO 892 for more references.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867.

The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

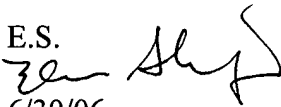
Art Unit: 2136

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.S.

6/30/06



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